

## R E M A R K S

In response to the Panel Decision mailed on October 1, 2007, and to the Non-final Office Action mailed on March 24, 2006 (hereinafter, the “Office Action”), Applicants hereby respectfully request continued examination in accordance with 37 C.F.R. §1.114. Enclosed herewith is a petition for a two-month extension of time to respond.

### **1. Status of the Claims**

After entry of this amendment, the status of the claims will be as follows:

- Claims **1-16, 18-31 and 33-98** are pending;
- Claims **1, 24, 33, 46-49, 94-97** have been amended;
- Claims **17 and 32** have been cancelled herein (claims **99-110** were cancelled previously);
- Claims **8-10, 16, 28, 29, 34, 38, 56-58, 64, 76, 77, 82 and 86** are withdrawn; and
- Claims **1, 13, 25, 49, 61 and 73** are considered by the Examiner to be generic [See Office Action mailed October 22, 2004 (Paper No./Mail Date 10152004)].

Applicants note that claims **8-10, 16, 28, 29, 34, 38, 56-58, 64, 76, 77, 82 and 86** are withdrawn, and have not been cancelled. Accordingly, the present amendment includes the text of these withdrawn claims. We understand that all of Claims **1-7, 11-15, 18-27, 30, 31, 33, 35-37, 39-55, 59-63, 65-75, 78-81, 83-85, and 87-98** will be examined. If this understanding is not correct, please contact Stephan Filipek at (203) 461-7252.

Applicants also note that claim **24** has been amended to correct a clerical error, as this claim should depend from claim **23** to provide for the proper antecedent basis. In addition, claim **33** has been amended to better conform to the wording of amended claim **1**. No new matter has been added.

In view of the above amendments and the following remarks, we respectfully request favorable reconsideration and allowance of the present application.

## 2. The 35 U.S.C. 103 Rejections

Claims 1-7, 11-15, 17-27, 30-33, 35-37, 39-55, 59-63, 65-75, 78-81, 83-85, and 87-98 stand rejected under Section 103(a) as allegedly being unpatentable over Gamble et al., U.S. Patent No. 6,014,632 (hereinafter “Gamble”) and Bro, U.S. Patent No. 5,722,418 (hereinafter “Bro”).

The Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. In re Fritch, 23 U.S.P.Q.2D 1780, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under Section 103, an examiner must show an unrebutted *prima facie* case of obviousness. In re Rouffet, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The factual predicates underlying an obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art. In re Rouffet. The secondary considerations are also essential components of the obviousness determination. In re Rouffet.

### 2.1. Claims 1-7, 11-15, 17-27, 30-33, 35-37 and 39-48 are Patentable over Gamble and Bro

Independent claim 1 has been amended to more distinctly claim the invention, and now recites:

*offering a benefit to the customer **toward** the transaction if the customer adopts the preventative treatment;*  
*receiving an indication that the customer agrees to adopt the preventative treatment; and*  
*providing the benefit.* (emphasis added)

Independent claims 46-48 have been amended in a similar manner. Support for such changes can be found, for example, on page 6, line 28 to page 7, line 3; on page 23, lines 3-13; and in claims 17 and 32 (which have been cancelled herein). No new matter has been added.

Claims **1 and 46-48** pertain to methods, apparatus and a computer-readable medium for providing a benefit to a customer. In particular, an indication is received that the customer is involved in a transaction with a third party, and then a determination is made regarding a preventative treatment for the customer. Next, the customer is offered a benefit toward the transaction between the customer and the third party if the customer adopts the preventative treatment. The benefit is provided after receiving an indication that the customer agrees to adopt the preventative treatment. We respectfully submit that neither Gamble nor Bro teaches or suggests such operation.

Gamble is directed to apparatus and methods for determining insurance benefit amounts based on groupings of long-term care patients. In particular, the apparatus and method is for efficiently producing an insurance product having an equitable arrangement of benefit amounts for patients requiring long-term care by providing benefit amounts that vary by patient category (see Gamble, col. 5, lines 50-55). The Examiner admits, in paragraph 3 of the Office Action, that Gamble does not disclose determining a preventative treatment, and does not disclose offering a benefit to the customer for the transaction if the customer adopts the preventative treatment. We respectfully submit that Bro does not cure these deficiencies of Gamble.

Bro discloses an automated and interactive positive motivational system for use by doctors, psychologists and the like to provide motivational messages and/or questions to clients, employees and patients having behavioral and various addiction, volitional or motivation problems (see Bro at col. 9, lines 14-19). Thus, the cited portions of Bro (Col. 4, lines 33-44 and Col. 13, lines 50-62) that purportedly teach to offer a benefit to a customer towards a transaction with a third party if the customer adopts a preventative treatment do not teach or suggest any such features. In fact, these portions recite the following:

“In research literature on social power and influence, the degree to which patients comply with the recommendations of health care practitioners has often been seen as directly related to the physicians' use of referent, reward and coercive powers. Generally, medical recommendations are mentally internalized by patients based upon the regard in which they hold the caregiver and the continuation of some form of positive reward or reinforcer. However, in modern medical practice, physicians have shown that they generally lack the time, inclination or financial incentives for the continuing monitoring of a patient's behavior and compliance with the prescribed regime.” (Col. 4, lines 33-44).

\* \* \* \* \*

“By mobilizing patients to accept responsibility for their own health through behavioral guidance in preventive health programs and to comply with medical prescriptions in the dispensing and taking of medicines, large savings can thereby be realized, contributing to national goals of medical cost containment. The aging of the population necessitates greater health care expenditures which in turn are aggravated by the possibility of older individuals having one or more chronic diseases wherein non-compliance with medical regimens can become financially costly, dangerous and even life-threatening. Likewise, large savings can accrue by keeping employees motivated and focused on assigned goals.” (Col. 13, lines 50-62)

Although Bro mentions “behavioral guidance” in “preventative health programs”, there is no teaching or suggestion to *offer a benefit to a customer towards a transaction* with a third party if the customer adopts the preventative treatment, as generally recited by independent claims **1 and 46-48**. In fact, Bro does not appear even to suggest any transaction, much less *providing a benefit* towards the transaction after *receiving an indication that the customer agrees to adopt the preventative treatment*, as required by these claims.

Consequently, we do not agree with the Examiner’s determination that it would have been obvious to combine the Gamble and Bro references. First, the Examiner has failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Consequently, we respectfully submit that the Examiner is unable to determine what “would have been obvious to one of ordinary skill in the business art” at the time of the invention. Second, it is unclear exactly how the insurance benefit amount system described by Gamble could be modified to incorporate an interactive telecommunications guidance system disclosed by Bro.

In view of the above remarks, applicants respectfully submit that it would not be obvious for someone determining insurance benefit amounts (as described in Gamble) to also utilize an expert and patient program that is designed to detect and manage chronic diseases (as described in Bro at col. 12, lines 47-64). But even if a motivation to combine Gamble and Bro were known in the prior art (which we dispute), the proposed combination would not provide for all of the specific features as recited by independent

claims **1 and 46-48**, for the reasons explained above. For example, no combination of any subject matter described in Gamble and Bro would provide for *offering a benefit to a customer towards a transaction (with a third party) if that customer adopts a preventative treatment* that has been determined for that customer.

Therefore, even if Gamble and Bro were combined as suggested, and we respectfully submit there is no teaching or suggestion for such a combination, the present invention would not be the result. Any such combination would fail to include offering a benefit to the customer **toward** the transaction if the customer adopts the preventative treatment that has been determined for the customer, and would fail to include receiving an indication that the customer agrees to the preventative treatment, and would fail to include providing the benefit (towards the transaction), as required by independent claims **1 and 46-48**. In addition, since claims **2-7, 11-15, 17-27, 30-33, 35-37 and 39-45** each directly or indirectly depend on claim **1**, these dependent claims should be allowable for at least the same reasons.

In view of the above remarks, the Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejections of claims **1-7, 11-15, 17-27, 30-33, 35-37 and 39-48**.

**2.2. Claims 49-55, 59-63, 65-75, 78-81, 83-85 and 87-96 are Patentable over Gamble and Bro**

Independent claim **49** has been amended, and now recites:

*receiving a first identification of a transaction involving a customer;*  
*transmitting a second identification of a preventative treatment to be adopted by the customer;*  
*receiving an indication that the preventative treatment has been adopted by the customer; and*  
*providing a benefit **to the customer toward** the transaction. (emphasis added)*

Independent claims **94-96** have been amended in a similar manner. Support for such changes can be found, for example, on page 6, line 28 to page 7, line 3, and on page 23, lines 3-13. No new matter has been added.

We respectfully submit that the Examiner has failed to cite any reference that teaches or suggests either of *receiving a first identification of a transaction involving a customer*, or of *transmitting a second identification of a preventative treatment to be adopted by the customer* as recited by claim 49. Gamble at col. 1, line 61 to col. 2, line 32 was cited for purportedly teaching such features. But the applicants submit that this cited portion has nothing whatsoever to do with such a process, as it recites:

“Second, beginning in October 1983, in response to rapidly rising hospital costs, Medicare began to reimburse hospitals using a prospective payment system based on Diagnosis Related Groups (DRGs). Before this change, seniors covered by Medicare remained hospitalized until, in most cases, they required only minimal assistance after discharge; this provided hospitals with a very strong financial incentive to keep patients hospitalized for as long as possible. But under the prospective payment system, each patient was assigned to one of 472 different DRGs, each of which had a specific dollar amount allotted to it. The dollar amount was based on the relative severity of the medical condition for the average patient. Except in extraordinary cases, Medicare paid the hospital that dollar amount for the patient's treatment, regardless of the severity of the patient's actual medical condition. In most cases, if the patient remained hospitalized too long, the hospital spent more for the patient's care than it received from Medicare.

Thus for the first time, hospitals had a very strong financial incentive to release patients before their Medicare money ran out. In 1968, the average hospital stay for seniors was 14.2 days; in 1982, the last year full before the prospective payment system was implemented, the average hospital stay had dropped to 10.1 days; and in 1996, the average hospital stay was only 6.6 days.

Today, almost half of all senior patients need skilled medical care--care that cannot be provided by friends or family--during their recovery after release from a hospital. Technological advances now allow most care provided in a nursing home to be provided in patients' homes. Thus, whether patients recover in a nursing home or in their own home now depends more often on what they can afford. Because home health care for recuperating patients is frequently more expensive than nursing home care, and because the combination of Medicare and private Medigap insurance policies can pay 100% of the costs for nursing home care during the first one hundred days, most recuperating patients are sent to nursing homes even though 75% to 80% strongly prefer to recover at home.” (Gamble, col. 1, line 61 to col. 2, line 32).

In addition, the same cited passages of Bro (col. 4, lines 33-44, and col. 13, lines 50-62) discussed above with regard to independent claims **1** and **46-48** were again cited as support for

the Examiner's positions for what is taught or suggested by the prior art with regard to other features of claim 49. However, we again submit that Bro does not suggest or teach *receiving an indication that the preventative treatment has been adopted by the customer, or providing a benefit to the customer toward the transaction* as recited by claim 49. Thus, for the purposes of brevity, we incorporate by reference herein the same arguments made above concerning the cited passages of Bro, and again respectfully traverse the Examiner's arguments for the same reasons.

In view of the above amendments and remarks, applicants submit that independent claims 49 and 94-96 are patentably distinct over the cited art. Moreover, since claims 50-55, 59-63, 65-75, 78-81, 83-85, and 87-93 all directly or indirectly depend from claim 49, these claims should also be allowable.

Accordingly, the applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejections of claims 49, 50-55, 59-63, 65-75, 78-81, 83-85, 87-93, and 94-96.

### 2.3. Claims 97 and 98 are Patentable over Gamble and Bro

Independent claim 97 has been amended to more distinctly claim the invention, and pertains to a method for providing a benefit that includes:

*receiving a first identification of a transaction between a customer and a third party;*  
*determining a preventative treatment and a benefit;*  
*transmitting a second identification of the preventative treatment and a third identification of the benefit to the customer;*  
*receiving an indication that the preventative treatment has been adopted by the customer; and*  
*providing the benefit toward the transaction between the customer and the third party in response to said indication. (emphasis added)*

Support for this change can be found, for example, on page 6, line 28 to page 7, line 3, and on page 23, lines 3-13. No new matter has been added.

Applicants note that the same cited passages of Gamble and Bro discussed above were again cited to support the Examiner's assertions for what is taught or suggested in the prior art. However, applicants were unable to identify any verbiage in either cited reference that even

*suggests transmitting a second identification of the preventative treatment and a third identification of the benefit to the customer, much less providing a benefit toward the transaction between the customer and the third party in response to the indication (that the preventative treatment has been adopted), as required by claim 97.* Thus, we incorporate herein by reference all of our arguments above regarding what Gamble and Bro fail to teach or suggest, and respectfully traverse the rejection of claim 97 for the same reasons set forth above.

Accordingly, independent claim 97 is patentably distinct over the cited art, and dependent claim 98 should be allowable for at least the same reasons. The applicants therefore respectfully request withdrawal of the 35 U.S.C. §103(a) rejections of claims 97 and 98.

### **Conclusion**

For the foregoing reasons it is submitted that all of the pending claims are in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

If there remains any question regarding the present application, or if the Examiner has any suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Stephan Filipek at telephone number 203-461-7252 or via electronic mail at [sfilipek@walkerdigital.com](mailto:sfilipek@walkerdigital.com).



**Petition for Extension of Time to Respond and Fees**

Applicants hereby petition for a two-month extension of time with which to respond to the Panel Decision mailed on October 1, 2007. Please charge the fee for this petition to our Deposit Account No. 50-0271, along with the fees pursuant to 37 C.F.R. 1.17(e) for this request for continued examination.

Applicants do not believe that any other fees are due. But if a fee should be necessary to continue prosecution of the present application, please charge any such required fee to our Deposit Account No. 50-0271, and credit any overpayment to Deposit Account No. 50-0271.

Respectfully submitted,

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Date

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